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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,965	12/07/2001	Mitsuaki Oshima	MTS-520US4	8891
7590	10/02/2003			
Allan Ratner Ratner & Prestia P.O. Box 980 Valley Forge, PA 19482			EXAMINER CALLAHAN, PAUL E	
			ART UNIT 2134	PAPER NUMBER 10
DATE MAILED: 10/02/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/017,965

Applicant(s)

M. OSHIMA ET AL.

Examiner

Paul E. Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/560,015.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Claims 31 and 32 are pending in this application and have been examined.
2. In the response filed 04/01/2003 the Applicant's Representative expressed concern over potential error in the numbering of the claims as they were treated in the previous Office Action in the case. It is the Applicant's Representative's expressed belief that there are two (2) claims pending in this application and that they are numbered claims 32 and 33. The Examiner has carefully reviewed the file history and finds the following history of the claims:
  - Claims 1-27: Original claims found in the Patent 5,761,301.
  - Claims 28-30: Added with the filing of this reissue divisional application 10/017,965 on 12/07/2001
  - Claims 1-27: Cancelled by the preliminary amendment filed 12/07/2001. This preliminary amendment mistakenly states, "New claims 28-31 have been newly added and attached to this divisional application." The Examiner finds that in fact that only claims 28-30 were added.
  - Claims 28-30: Cancelled by the supplemental preliminary amendment filed 07/21/2002. The amendment mistakenly states: "Please cancel claims 28-31" The Examiner finds only claims 28-30 were pending at that time. New claims 31 and 32 were added.

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- Claims 31 and 32 were pending as of the filing date of the latest communication from the Applicant's Representative, i.e., the response to the non-final Office Action mailed 12-03-2002.

***Terminal Disclaimer***

3. The terminal disclaimer filed on 4-1-2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any Patent granted on pending US Application No. 09/588,364 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The terminal disclaimer is effective in overcoming the rejection of claims 31 and 32 under 35 USC 101 statutory-type double patenting as found in the previous Office Action in the case.

***Reissue Applications***

4. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,761,301 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

5. The reissue oath/declaration filed 04/01/2003 is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

(a). The reissue declaration states: "More specifically, the inventors did not claim any one of the features of trimming the reflective layer of an optical disk to form a barcode pattern, where the barcode pattern is formed on a track of the disk. In addition, the inventors did not claim any one of the features of trimming the reflective film of an optical disk to form a marking by a laser, where the marking is formed on the track of the disk." The pending claims however, do not correct any one of these errors.

Neither of the pending claims contains a limitation directed towards formation of a mark on a reflective film (layer) of an optical disk.

Both of the currently pending claims 31 and 32 do contain language directed towards formation of a barcode pattern via a laser, however since claim 31 is directed towards an article of manufacture, i.e., an optical disk comprising...and a barcode pattern formed by a laser on said track, the process by which it is produced (laser trimming) is not given patentable weight. The inclusion of laser trimming in claim 31 does not serve to cure any stated error found in the declaration.

(b). The error stated in the Reissue Oath / Declaration is the same as that stated in the parent reissue application. In fact the Applicant's Representative states in paragraph (5) of the current amendment "The substitute declaration is a copy of the substitute declaration submitted in the parent Reissue application no. 09/588,364." Therefore the error will have been corrected in

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the parent application and the declaration found in the instant application no. 10/017,965 is still objected to on the basis that the stated error no longer exists. See MPEP 1414(II).

6. Claims 31 and 32 are rejected as being based upon a defective reissue oath or declaration under 35 USC 251 as set forth supra. See 37 CFR 1.175. The nature of the defects in the declaration are set forth supra.

***Response to Arguments***

7. Applicant's arguments filed 4-1-2003 have been fully considered but they are not persuasive.

The Applicant argues in traverse of the rejection of claims 31 and 32 that the prior art applied, Ikeda, US 5,050,150, does not teach the feature of forming barcode marks via laser. The Examiner counters by noting that such is taught by Ikeda at col. 1 lines 30-35 where the barcodes are described as being formed by "a plurality of pit trains" and col. 4 lines 29-37 where such pits are taught as being formed on the disk via a laser.

The Applicant argues that Ikeda does not teach the features of forming a track of spiral shape and then forming the barcodes on the track. The Examiner counters by noting that such is taught in fig. 1 where the bar code marks of Ikeda are shown to be formed on a spiral track (item 1b). the applicant argues that spiral tracks as known in the art are generally continuous. However the tracks formed on optical disks are generally composed of pit trains with discontinuous groupings of such trains, as is shown by the barcodes of Ikeda.

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The Applicant argues that Ikeda does not teach formation of the bar codes on or in a spiral track. The Examiner counters that Ikeda teaches such at col. 3 lines 4-11. In addition, in col. 3 lines 37-43 Ikeda teaches the barcodes includes sector and track information used by the optical reader in reading the bar code information.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 31 and 32 are rejected under 35 USC 102(b) as being clearly anticipated by Ikeda, US 5,050,150. No changes have been made to the language of the claims by the latest amendment and therefore no changes to the rejections of the claims are necessary. The text of the rejections of the claims will not be repeated herein but instead are hereby incorporated in their entirety by reference to the previous Office Action in the case.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

9/23/03

*Paul Callahan*

*Gregory Morse*  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
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